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09/750,203	12/28/2000	Donald A. Williams	TEL-001	6978

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EXAMINER	
MOORE, IAN N	

ART UNIT	PAPER NUMBER
2661	5

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/750,203	WILLIAMS, DONALD A.	
	Examiner	Art Unit	
	Ian N Moore	2661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-8 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-8 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 2.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 6 is objected to because of the following informalities: "...call **my** be connected..." For consistency, it should be changed to "...call **may** be connected..." Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Ertugrul (U.S. 202/0087645A1).

Regarding Claims 1 and 2, Ertugrul'645 discloses a method for enhancing the use of the Internet **(see page 3, paragraph 37; voice-over-IP communication)**, comprising:

installing software into an Internet connection device **(see FIG. 5, Recipient personal computer; see page 2, paragraph 11; note that voice-over-IP service is being acquired by the customers (i.e. sender and receiver). Thus, it is clear that recipient computer must be Internet connection computer)** to enable said connection device to add a link **(see FIG. 2, voice label 204)** to an e-mail message **(see FIG. 2, e-mail message 200)** requesting a recipient of the e-mail **(see FIG. 2, a recipient 212)** to place a telephone call to

a designated telephone number **(see page 3, paragraph 37; page 1, paragraph 9; note that upon selecting a voice label/button in the e-mail message, the recipient computer will automatically download/install an applet/software in order to initiate/place a voice-over-IP conversation with the designated sender's telephone/modem number)**; and

wherein said link includes information to enable the e-mail recipient **(see FIG. 2, a recipient 212)** to download a computer program **(see page 1, paragraph 9; a software package)** into the e-mail recipient's computer **(see FIG. 2, a recipient 212 computer)** to facilitate the placing of said telephone call from the e-mail recipient's computer **(see page 3, paragraph 26; note that the voice label includes the information which cause/enable the recipient computer to download an applet/software to place a voice-over-IP conversation)**.

3. Claim 5,7, and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Edwards (U.S. 6,502,127).

Regarding Claims 5,7, and 8, Edwards'127 discloses a method of providing communications, comprising:

receiving on a first server **(see FIG. 1, E-mail server 40)** an e-mail transmission from a first Internet connection device originated by a first e-mail user **(see FIG. 1, a message from the first worker A desktop/personal computer 30 which connects to Internet 16; see col. 4, lines 32-33, 37-38)**, said e-mail transmission including a link which when displayed on a second Internet connection device **(see FIG. 3C, a call back 326 link displays on e-mail message of the worker B/C; see col. 5, lines 27-29)** enables a second e-

mail user of said second Internet connection device **(see FIG. 1, second worker B/C desktop/personal computer 30 connects to Internet 16; see col. 4, lines 32-33, 37-38)** to initiate voice communication between said second Internet connection device and a telephone number specified in said link **(see col. 5, lines 36-47; note that when the call back link/button is selected, a voice communication is setup between the desktop computer and the accounting department telephone 25)**;

transmitting said e-mail message from said first server to an address of said second Internet connection device **(see col. 4, lines 40-52; note that e-mail message from the email server 40 is transmitted to the e-mail client 130 of the worker B/C desktop computer 30)**; and

generating a telephone call **(see FIG. 1, by selecting a call back 326 button)** from said second Internet connecting device to said telephone number **(see col. 5, lines 36-47; note that when the call back link/button is selected it, a voice communication is setup between the worker B/C computer and the accounting department telephone 25)**.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claim 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ertugrul'645 in view of Ma (U.S. 6,373,857).

Regarding claim 3, Ertugrul'645 discloses a method of communication utilizing the Internet **(see page 3, paragraph 37; voice-over-IP communication)**, comprising:

receiving on a server **(see FIG. 1, Recipient E-mail Server)** an e-mail message transmitted from a first computer **(see FIG. 1, Sender E-mail client computer; see page 1, paragraph 9)**, which email message **(see FIG. 2, e-mail message 200)** includes a request to an intended recipient of the e-mail **(see FIG. 2, a recipient 212 email address)** for a return telephone call **(see FIG. 2, voice label 204)** to a telephone number designated in the e-mail **(see page 3, paragraph 37; page 1, paragraph 9; note that the email message contains a voice label/button requesting a recipient computer to initiate/place a phone call with the sender's telephone/modem number)**;

transmitting said e-mail message to a second computer **(see FIG. 1, Recipient E-mail Client computer)** specified in an address associated with said e-mail message **(see FIG. 1, Recipient E-mail server sends e-mail message to Recipient E-mail client address (i.e. recipient address 212, see FIG. 2); see page 3, paragraph 34-35)**;

a telephone call originated on said second computer may be routed to said telephone number designated in said e-mail message **(see page 3, paragraph 26; note that the by selecting a voice label in the email message of the recipient's computer causes the a voice call back to the sender's telephone/modem number)**.

wherein said link includes information to enable the e-mail recipient **(see FIG. 2, a recipient 212)** to download a computer program **(see page 1, paragraph 9; a software**

package) into the e-mail recipient's computer **(see FIG. 2, a recipient 212 computer)** to facilitate the placing of said telephone call from the e-mail recipient's computer **(see page 3, paragraph 26; note that the voice label includes the information to cause/enable the recipient computer to download an applet/software to place a voice-over-IP conversation)**,

Ertugrul'645 does not explicitly disclose including in said e-mail transmission the address of a gatekeeper, said gatekeeper adapted to supply an address of a gateway.

However, the above-mentioned claimed limitations are taught by Ma'857. In particular, Ma'857 teaches transmission of the address of a gatekeeper **(see FIG. 1, Gatekeeper 108 or 109; FIG. 4, step 402-406; note that a gatekeeper address is transmitted)** said gatekeeper adapted to supply an address of a gateway **(see FIG. 1, Gateway 104 or 106; see col. 7, lines 20-44; note that gatekeeper must administer the gateways addresses in order to setup the connection)** through which a telephone call originated on said second computer may be routed to said telephone number **(see col. 4, lines 53-62 and col. 5, lines 6-18; note that gateways provides the translations between transmission formats. Thus, it clears that the call between computer terminals 121 and 118 can be routed to telephone 112 via gateways)**. Also, note that Ertugrul'645 teaches a server connecting between two Internet connection computers to route e-mail message. Ma'857 teaches a requested message includes the gatekeeper address (see Ma'857 col. 7, lines 23-32). Thus, it is clear that Ertugrul'645's email message to the second/recipient computer can include a gatekeeper address so that the recipient can set-up a call with the utilizing appropriate gateway per Ma'857's teachings.

In view of this, having the system of Ertugrul'645 and then given the teaching of Ma'857, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Ertugrul'645, by providing a gatekeeper and gateway to set up the call, as taught by Ma'857. The motivation to combine is to obtain the advantages/benefits taught by Ma'857 since Ma'857 states at col. 1, line 65 to col.2, lines 1 that such modification would provide address resolution, call admission control and bandwidth management.

Regarding claim 4, the combined system of Ertugrul'645 and Ma'857 discloses all aspects of the claimed invention set forth in the rejection of Claim 3 as described above, and Ertugrul'645 further teaches wherein authentication information is supplied in the e-mail about the e-mail user sending the e-mail (**see FIG. 3, user table 300, see page 5, paragraph 48-53; note the authentication/security information of the email user is supplied in the email message**). Ma'857 discloses wherein said gatekeeper is further adapted to confirm authentication information supplied in the message (**see col. 4, lines 25-31; note that the gatekeeper performs the administrative and control functions. Thus, it is clear that it must confirm the valid user from the call set up request message before establishing the connection**).

In view of this, having the system of Ertugrul'645 and then given the teaching of Ma'857, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Ertugrul'645, by providing a gatekeeper, as taught by Ma'857, for the same motivation as stated above in Claim 3.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards'127 in view of Ma'857.

Regarding claim 6, Edwards'127 discloses said second Internet connection device generating said telephone call may be connected to said telephone number as described above in claim 5.

Edwards'127 does not explicitly disclose obtaining from a gatekeeper the address of a gateway.

However, the above-mentioned claimed limitations are taught by Ma'857. In particular, Ma'857 teaches the Internet connection device **(see FIG. 1, the calling end points 1112,116,118, or 114 device)** obtaining the from a gatekeeper **(see FIG. 1, Gatekeeper 108 or 109)** the address of a gateway **(see FIG. 1, Gateway 104 or 106; FIG. 4, step 402-406; see col. 7, lines 20-44; note that a gatekeeper address is obtained by the endpoint device, and each gatekeeper administers the gateways address in order to setup the connection. Thus, each endpoint obtains the gateway address via a gatekeeper)** through which said telephone call may be connected to said telephone number **(see col. 4, lines 53-62 and col. 5, lines 6-18; the call between computer terminals 121 and 118 can be routed to telephone 112 via gateways)**.

In view of this, having the system of Edwards'127 and then given the teaching of Ma'857, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Edwards'127, by providing a gatekeeper and gateway to set up the call, as taught by Ma'857. The motivation to combine is to obtain the

advantages/benefits taught by Ma'857 since Ma'857 states at col. 1, line 65 to col.2, lines 1 that such modification would provide address resolution, call admission control and bandwidth management.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ian N Moore whose telephone number is 703-605-1531. The examiner can normally be reached on M-F: 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Ngo can be reached on 703-305-4798. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

INM
3/31/04

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